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| 09/659,363  | 09/12/2000  | Troy Eric Echols     | Echols2             | 4841             |
| 24283   | 7590        | 09/09/2005           | EXAMINER            |                  |
| PATTON BOGGS<br>1660 LINCOLN ST<br>SUITE 2050<br>DENVER, CO 80264 |             |                      | CHANG, RICHARD      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2663                |                  |

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/659,363

Applicant(s)

ECHOLS, TROY ERIC

Examiner

Richard Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 16-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments and amendments with respect to claims 1-15 filled 06/25/2005 have been fully considered but they are not persuasive.

Regarding claim 1-15 In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "The packet-based terminal device addressing system presumes that the owner of the packet-based terminal device also owns a circuit-based terminal device and therefore reuses the point of presence address of the circuit-based terminal device.") are not explicitly recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Newly added Claims 16-18 have been fully considered.

### ***Claim Objections***

2. Claims 16-18 are objected to because of the following informalities:

Regarding to Claims 16-18, the phrase "responsive to said calling party selecting a one of said called party's circuit-based terminal" (claim 16-18, line 5) is mistyped and unclear. This should be corrected as "responsive to said calling party selecting one of said called party's circuit-based terminal" to be consistent with the disclosure.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US patent No. 6,490,274 ("Kim").

Regarding claims 1, 6 and 11, Kim teaches a method and system for internet (254) cable phone (208, packet based terminal device) telephony service over internet protocol (IP) (addressing system) for enabling a calling party using a public switched telephone network (PSTN, 260) phone (256, circuit based terminal device); which is addressable via a telephone number, to initiate a communication connection to a called party who is using an IP addressable cable phone (208, a packet-based terminal device, which is addressable via an IP address) (See Fig. 2) comprising

directory information base (DIB, 218 as data storage means), for storing data in as a memory indicative of a correspondence between at least one IP address assigned to a 1<sup>ST</sup> cable phone (208, said called party's packet-based

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terminal device) and a corresponding PSTN telephone number assigned to 1<sup>ST</sup> cable phone (208, said called party's circuit-based terminal device),

1<sup>st</sup> headend unit (202 as terminal device location means), responsive to receipt of data from said calling party indicative of said called party's telephone numbers corresponding to 1<sup>ST</sup> cable phone (208, said called party's circuit-based terminal device), for retrieving data from DIB (208, said memory indicative of said IP address) assigned to a 1<sup>ST</sup> cable phone (208, called party's packet-based terminal device), and

1<sup>st</sup> router (216 as communication connection means), for establishing a communication connection between 1<sup>ST</sup> PSTN phone (256, said calling party's circuit-based terminal device) to 1<sup>ST</sup> cable phone (208, said called party's packet-based terminal device) (See Fig. 2, Col. 3, lines 53-67),

wherein the 1<sup>st</sup> Internet telephony Gate ITG (220) interacting with above units also performs as local exchange carrier function.

Regarding claims 2, 7 and 12, Kim further teaches that 1<sup>st</sup> headend (220 as terminal device locator means) for transmitting said IP address assigned to 1<sup>ST</sup> cable phone (208, said called party's packet-based terminal device) to at least one 1<sup>st</sup> Internet telephony gateways (ITG, 220 as packet-based communication service) to locate 1<sup>ST</sup> cable phone (208, said called party's packet-based terminal device).

Regarding claims 3, 8 and 13, Kim further teaches that

1<sup>st</sup> headend (220 as inquiry response means), responsive to receipt of a message from one of said at least one 1<sup>st</sup> ITG (220 as packet-based

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communication services) indicative of a presence of 1<sup>ST</sup> cable phone (208, said called party's packet-based terminal device) on said one of said at least one 1<sup>st</sup> ITG (220 as packet-based communication services), for extending a communication connection from 1<sup>ST</sup> PSTN phone (256, said calling party's circuit-based terminal device) to said one of said at least one 1<sup>st</sup> ITG (220 as packet-based communication services).

Regarding claims 4, 9 and 14. Kim further teaches that 1<sup>st</sup> DIB (218 as directory means) for storing a set of data comprising data indicative of an IP address assigned to each of a plurality of a of 1<sup>ST</sup> cable phone (208, called party's packet-based terminal device).

Regarding claims 5, 10 and 15. Kim further teaches that 1<sup>st</sup> headend unit (202 as destination selection means) for providing said calling party with a list of 1<sup>ST</sup> cable phones (208, said called party's packet-based terminal devices), and 1<sup>st</sup> ITG (220 as service identification means), responsive to said calling party selecting a one of 1<sup>ST</sup> cable phones (208, said called party's packet-based terminal devices), for identifying a 1<sup>st</sup> ITG (220 as packet-based communication services) serving of 1<sup>ST</sup> cable phones (208, said called party's packet-based terminal devices)  
(See Fig. 2 and Fig. 4, Col. 5, lines 3-25).

### ***Allowable Subject Matter***

5. Claims 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

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limitations of the base claim and any intervening claims and if no art rejection can be applied.

***Examiner's Statement of Reasons for Allowance***

6. The following is an examiner's statement of reasons for allowance:

The prior art along or in combination fails to teach or make obvious the following limitations:

"means, responsive to a calling party, connected to PTSN via a Local Exchange Carrier serving said calling party, dialing the telephone number assigned to said circuit-base terminal device of said called party, for transmitting said telephone number to a Local Exchange Carrier serving said calling party; and  
means for providing said calling party with a list of said called party circuit-based terminal devices and said called party's packet-based terminal devices; and means, responsive to said calling party selecting one of said called party's circuit-based terminal devices and said called party's packet-based terminal devices, for identifying a communication service serving said selected one of said called party's circuit-based terminal devices and said called party's packet-based terminal devices." as recited in the independent claims 16-18.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Chang whose telephone number is (571) 272-3129. The examiner can normally be reached on Monday - Friday from 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*RKC*  
rkc

Richard Chang  
Patent Examiner  
Art Unit 2663

  
RICKY NGO  
PRIMARY EXAMINER  
*9/6/05*